

Appl. No. 09/275,514

Attorney Docket: 042390.P7034

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated April 06, 2005, in which:

- claims 1-16, and 19-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis *et al.* (hereafter, 'Lewis,' US Patent No. 6,385,388 B1) in combination with Hsu (US Patent No. 6,195,692 B1) in further combination with DirecTV;
- and claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis in combination with Hsu and DirecTV in further combination with DirecTV in further combination with "Ratings, Filters, and Censorship" by Gary Robson (hereafter, 'Robson').

Reconsideration of the above referenced patent application in view of the following remarks is respectfully requested.

Claims 1-32 are now pending the above referenced patent application. No claims have been amended, cancelled, or added.

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1. 35 U.S.C. § 103(a)

1.1. *Lewis and Hsu: Claims 1-16, and 19-32*

The PTO has also rejected claims 1-16, and 19-32 under 35 U.S.C. § 103(a) based upon Lewis and Hsu in combination with DirecTV. The rejection of these claims is respectfully traversed.

M.P.E.P. § 706.02(j) sets forth the standard for a § 103(a) rejection:

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (whitespace added).

1.1.1. Official Notice

It is noted that the Office Action does not cite Official Notice in the summary paragraph of the rejection (page 3, paragraph 3); however, the term Official Notice occasionally appears within the detailed explanation of the rejection of various claims.

Applicants are unsure if the PTO intended to base the rejection on this Official Notice or if the Notice had been withdrawn and merely inadvertently included from previous Office Actions.

Regardless, the PTO's Official Notice of the use of "business choice" is respectfully traversed. The PTO claims "Official notice it [sic] taken that it would have been obvious to one

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of ordinary skill in the art at the time the invention was made that it is a business choice to select what part of [sic] data stream need [sic] to be scrambled to prevent unintended use of the data."

Applicants respectfully note that the PTO is not taking Official Notice of a technology or bit of scientific knowledge, but instead the PTO is taking Official Notice of what one skilled in the art would consider obvious. In other words, the PTO is attempting to establish a *prima facie* case of obviousness by taking Official Notice of the legal conclusion of obviousness. M.P.E.P. § 2144.03, which deals with Official Notice, is entitled "Reliance on Common Knowledge in the Art or 'Well Known' Prior Art," and in the first sentence clearly directs Official Notice only to findings of fact. It is respectfully asserted the Official Notice is inappropriate, because the PTO may not take Official Notice of a legal conclusion, but instead must limit itself to findings of fact regarding prior art.

Furthermore, Applicants have previously traversed a similar Official Notice and requested that the PTO provide documentary evidence supporting the Notice. Applicants respectfully assert that M.P.E.P. § 2144.03(C) requires that "the Examiner Must Support the Finding With Adequate Evidence." As far as Applicants can tell, this has not been done. Applicants note that this may be because the Notice was withdrawn but inadvertently included from a previous Office Action in the detailed discussion of the claim rejections.

As detailed in M.P.E.P. § 2144.03, the standard of review applied to findings of fact is the "substantial evidence" standard under the Administrative Procedure Act (APA). See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). Applicants respectfully request that the PTO furnish documentary evidence showing prior art that alone or in combination meets all the elements of the Applicants' claimed subject matter and showing why one skilled in that art would be motivated to combine the subject matter of the other cited art.

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1.1.2. Remarks

Applicants begin with claim 1. Claim 1 recites:

- 1 1. (Previously Presented) A method of providing content to a receiving device having an
2 associated identifier associated with a network address for the receiving device, comprising:
3 selecting a set of segments of content from a group of segments to be protected wherein
4 the set does not include all segments of the group;
5 protecting the segments of the set, but not the other segments of the group, to prevent the
6 protected segments from being properly reproduced unless the protection is undone with
7 assistance of a correct key that is not generally available and is based at least in part on the
8 associated identifier; and
9 providing access to the group of segments over a network.

Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

It is respectfully asserted that neither Lewis, Hsu, nor DirecTV, either alone or in combination, suggests or describes decrypting the segments utilizing a correct key that is ... based at least in part on the associated identifier. The PTO asserts that the DirecTV teaches this limitation. However, it is respectfully asserted that DirecTV does not teach this limitation.

DirecTV instead shows an access card that must be activated prior to decrypting content. See DirecTV, page 15, paragraph 9. Applicants admit that at a cursory level this resembles portions of claim 1, but it does not actually meet the § 103 requirement to “teach or suggest all the claim limitations.” The DirecTV document is silent on how the device decryption actually works. The reader (be it the PTO or the Applicants) is required to guess as to how the decryption functions.

For example, the DirecTV access card may decrypt signals based upon:

1. a key, universal to all DirecTV access cards, that is transmitted from the satellite to the card;

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2. a key, universal to all DirecTV access cards, that is transmitted to the card via the DirecTV telephone line via activation; or
3. a key, universal to all DirecTV access cards, that is embedded within the access card but not activated until a control signal is received from the satellite.

Applicants point out that all of these suggestions as to how the DirecTV reference fulfills the decryption function are guesses, because the DirecTV document is silent on how the decryption is done. These guesses are just as valid as the PTO's guess that the way the DirecTV system decodes signals based upon an identifier, associated with the access card (as opposed to a universal key).

Tangentially, Applicants respectfully assert that their guess #3 is similar to the way XM Satellite Radio works, and is therefore more probable than the PTO's guess. It is unlikely that DirecTV encodes their broadcast in such a way that there is a key associated with an identifier on each card. DirecTV issues a single broadcast to all or half the United States (Applicants are unsure if DirecTV has both an East and a West Coast satellite). Thousands, if not millions, of receivers receive the exact same broadcast from the satellite. It is unlikely that the satellite would utilize the limited bandwidth available to it to transmit thousands, if not millions, of versions of the broadcast each version requiring a decryption key that is based upon the identifier associated with each user's access card.

It is respectfully asserted that the Code does not allow prior art that may possibly within some variation produce a limitation included within the claims. Instead, the Code specifies that the cited art must explicitly teach or suggest the limitation. It is respectfully asserted that all the DirecTV teaches is an access card, not a "correct key that is not generally available and is based at least in part on the associated identifier."

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Under the requirements for §103, the prior art reference (or references when combined) must teach or suggest all the claim limitations. It is respectfully asserted that neither Lewis, Hsu, nor DirecTV, either alone or in combination, suggests or describes a receiving device having **“correct key that is not generally available and is based at least in part on the associated identifier.”**

Therefore, even if the combination were proper, although Applicants believe that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

1.1.3. Remaining Claims

Claims 2-16, and 19-32 either depend from and include the limitations of claim 1, or include a substantially similar and patentably distinct limitation as claim 1. Therefore, these claims patentably distinguish from the cited patents on the same basis as claim 1. It is, therefore, respectfully requested that the PTO withdraw the rejections of these claims.

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1.2. Lewis, Hsu, DirectTV, & Robson: Claims 17 and 18**1.2.1. Remarks**

The PTO has also rejected claims 17 and 18 under 35 U.S.C. § 103(a) on Lewis, Hsu, DirectTV and in combination with Robson. The rejection of these claims is also traversed.

Applicant begins with claim 17. Claim 17 recites:

1 17. (Original) The method of claim 12, wherein information identifying protected segments is
2 contained in at least one watermark.

Claim 17 ultimately depends from the independent claim 12. Claim 12 recites:

1 12. (Previously Presented) A method of receiving and processing content by at least one
2 receiving device having an associated identifier with a network address for the receiving device,
3 comprising:
4 accessing over a network a group of segments of content including a set of segments that
5 does not include all segments of the group, and wherein the set, but not the other segments of the
6 group, have been protected to prevent the protected segments from being properly reproduced
7 without undoing the protection with assistance of a correct key that is not generally available and
8 is based at least in part on the associated identifier;
9 undoing the protection if the correct key is received; and
10 playing the group of segments seamlessly with a media player.

Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

It is respectfully asserted that neither Lewis, Hsu, DirectTV, nor the Robson, either alone or in combination, suggests or describes a correct key that is ... based at least in part on the associated identifier.

As described in detail above, the PTO asserts that the DirectTV teaches this limitation. However, it is respectfully asserted that DirectTV does not teach this limitation. DirectTV instead

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shows an access card that must be activated prior to decrypting content. See DirecTV, page 15, paragraph 9. The DirecTV document is silent on how the device decryption actually works. The reader (be it the PTO or the Applicants) is required to guess as to how the decryption functions. Because the Code specifies that the cited art must explicitly teach or suggest the limitation, DirecTV does not meet the standard set for establishing a *prima facie* case of obviousness.

Therefore, even if the combination were proper, although Applicants believe that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

Claim 18 either depend from and include the limitations of claims 17 or 12, or include a substantially similar and patentably distinct limitation as claim 17 or 12. Therefore, these claims patentably distinguish from the cited patents on the same basis as claim 17 or 12. It is, therefore, respectfully requested that the PTO withdraw the rejections of these claims.

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CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,



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